

### Remarks/Arguments

#### **A. Pending Claims**

Claims 1608-1611, 1613-1615, 1617-1650, 1652-1657, 1659-1685, 5396-5400, 5402-5407, and 5409-5415 are currently pending. Claims 1608, 1617, 1631, 1647, 1656, 1670, 5400, and 5407 have been amended. Claims 1617, 1631, 1656, 1670, and 5407 have been amended for clarification. Claims 1616, 1658, and 5408 have been cancelled. Claims 5413-5415 are new.

#### **B. Provisional Double Patenting Rejection**

The Examiner provisionally rejected claims 1608-1611, 1613-1650, 1652-1685, 5396-5400, and 5402-5412 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1638-1640 and 1677-1679 of copending Application No. 09/840,937; claims 1638-1640 and 1677-1679 of copending Application No. 09/841,288; claims 1634, 1673, and 5408 of copending Application No. 09/841,291; claims 1624 and 1633 of copending Application No. 09/841,300; claims 1634, 1673, and 5408 of copending Application No. 09/841,432; claims 1625 and 1664 of copending Application No. 09/841,438; claims 1638-1640 and 1677-1679 of copending Application No. 09/841,445; claims 1625 and 1664 of copending Application No. 09/841,495; claims 1634, 1673, and 5408 of copending Application No. 09/841,638; and claims 1623 and 1662 of copending Application No. 09/841,639. Applicant respectfully requests reconsideration of the provisional double patenting rejections in light of the current amendments.

#### **C. The Claims Are Not Anticipated By Bock Pursuant To 35 U.S.C. § 102(b)**

The Examiner rejected claims 1608, 1610, 1647, 1649, 5398, 5399, 5400, and 5403 under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 4,458,757 to Bock et al. (hereinafter “Bock”). Applicant respectfully disagrees with these rejections.

On page 11 of the Office Action, the Examiner states: “Claims 1616, 1619, 1623-1625,

1634, 1638-1640, 1655, 1658, 1662-1664, 1673, 1677-1679, 5406, and 5408 have been identified as including subject matter which is allowable over the prior art.”

Independent claim 1608 has been amended to include features of claim 1616. Amended claim 1608 describes a combination of features including: “pyrolyzing hydrocarbons in the part of the formation” and “controlling the heat such that an average heating rate of the part of the formation is less than about 1 °C per day in a pyrolysis temperature range of about 270 °C to about 400 °C”.

Independent claim 1647 has been amended to include features of claim 1658. Amended claim 1647 describes a combination of features including: “wherein allowing the heat to transfer to the part of the formation heats the part of the formation to increase a thermal conductivity of at least a portion of the part of the formation to greater than about 0.5 W/(m °C).”

Independent claim 5400 has been amended to include features of claim 5408. Amended claim 5400 describes a combination of features including: “controlling a pressure in at least a majority of the part of the formation, wherein the controlled pressure is at least about 2.0 bars absolute”.

Applicant submits that Bock does not appear to teach or suggest at least the combinations of features in amended claims 1608, 1647, and 5400, including but not limited to the above-quoted features of amended claims 1608, 1647, and 5400. Applicant respectfully requests removal of the rejections of claims 1608, 1647, 5400, and the claims dependent thereon.

**D. The Claims Are Not Obvious Over Van Meurs In View of Bock Pursuant To 35 U.S.C. 103(a)**

The Examiner rejected claims 1608-1611, 1617, 1618, 1620-1622, 1626-1633, 1635, 1636, 1641-1650, 1656, 1657, 1659-1661, 1665-1672, 1674, 1675, 1680-1685, 5396-5400, 5402, 5403, 5407, 5411, and 5412 under 35 U.S.C. 103(a) as obvious over U.S. Patent No.

4,886,118 to Van Meurs et al. (hereinafter "Van Meurs") in view of Bock. Applicant respectfully disagrees with these rejections.

Claims 1608, 1647, and 5400 have been amended to include features of claims 1616, 1678, and 5408, respectively. Claims 1616, 1678, and 5408 have been identified by the Examiner as including subject matter that is allowable over the prior art. Applicant submits that at least the above-quoted features of claims 1608, 1647, and 5400 do not appear to be taught or suggested by Van Meurs in view of Bock. Applicant respectfully requests removal of the rejections of claims 1608, 1647, 5400, and the claims dependent thereon.

If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Applicant submits, in addition, that many of the claims dependent on claims 1608, 1647, and 5400 are separately patentable.

The Examiner states: "With regards to claims 1620-1622, 1626-1632, 1635, 1636; the nature of hydrocarbons produced from such heating is highly variable, and dependent upon many factors, not least of which is the characteristics of the coal. The components of the produced mixture are deemed to be the results of design variables, including coal characteristics and temperature." The Examiner makes similar statements about claims 1659-1661, 1665-1671, 1674, 1675, and 5409.

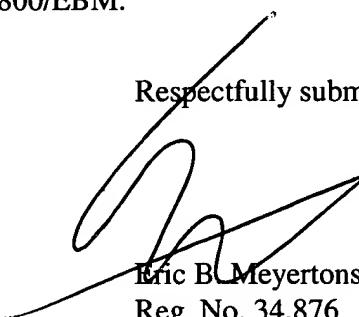
Applicant submits that there is no evidence that the product mixtures recited in claims 1620-1622, 1626-1632, 1635, 1636, 1659-1661, 1665-1671, 1674, 1675, and 5409 would be producible by carrying out the heating process of Van Meurs or Bock. The product mixtures recited in claims 1620-1622, 1626-1632, 1635, 1636, 1659-1661, 1665-1671, 1674, 1675, and 5409 may be produced by controlling and/or modifying formation conditions during treatment to produce the selected results recited in the claims. Applicant respectfully requests removal of the rejections of claims 1620-1622, 1626-1632, 1635, 1636, 1659-1661, 1665-1671, 1674, 1675, and 5409.

**E. Additional Comments**

Applicant submits that new claims 5413-5415 include matter from previously presented claim 1639. Applicant submits that all claims are in condition for allowance. Favorable consideration is respectfully requested.

Applicant believes that no fees are due in association with the filing of this document. If any extension of time is required, Applicant hereby requests the appropriate extension of time. If any fees are required, please charge those fees to Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C. Deposit Account Number 50-1505/5659-01800/EBM.

Respectfully submitted,



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